

## REMARKS

Upon entry of this Response, claims 26-46 remain present and active in the application with claims 29-32, 36-38, and 45 being presently withdrawn as drawn to non-elected species.

### Request for Personal Interview with Examiner

Unless all of the outstanding grounds of objection and rejection are withdrawn in light of the remarks below, Applicants respectfully request a personal interview with the Examiner in accordance with MPEP § 713.01 prior to the issuance of any further rejections by the Office.

### Previously Filed Information Disclosure Statements

The Form PTO-1449 submitted with Applicants' Information Disclosure Statement dated October 24, 2003 was processed and returned by the Office with the Office Action dated May 29, 2008. However, References A4 and A5 identified thereon were not considered by the Examiner even though English language abstracts serving as concise explanations of their relevance were provided to the Office in accordance with 37 CFR § 1.98(a)(3)(i). Thus, consideration of these references is respectfully requested inasmuch as the mandates of 37 CFR § 1.98(a)(3)(i) have been fulfilled.

The Form PTO-1449 submitted with Applicants' Second Supplemental Information Disclosure Statement dated October 5, 2007 was likewise processed and returned by the Office with the Office Action dated May 29, 2008. However, Reference C1 identified thereon was not considered by the Examiner even though a full English translation was provided to the Office in accordance with 37 CFR § 1.98(a)(3)(ii). Consideration of this reference is respectfully requested inasmuch as the mandates of 37 CFR § 1.98(a)(3)(ii) have been fulfilled.

Finally, as noted in Applicants' Response dated October 5, 2007, the Form PTO-1449 submitted with Applicants' First Supplemental Information Disclosure Statement dated July 9, 2004 was processed and returned by the Office with the Office Action mailed on July 27, 2006. Although the Examiner signed and dated the signature blocks

on the bottom of this form, the leftmost boxes adjacent the individual citations were not initialed as required by MPEP 609.05(b). Thus, to ensure that all citations identified on this form will be printed on any patent that may issue from the present application, Applicants respectfully request that the Examiner kindly initial each of the listed citations for the record.

#### **Objection to Drawings**

The objection to the drawings under 37 CFR 1.83(a) as allegedly failing to show every feature of the claimed invention is respectfully traversed. The "detection unit" recited in the claims is clearly shown in the drawings.

By way of example, photomultiplier tube 124 and photodiode 125 serve as representative detection units in some embodiments of the claimed invention as described in the specification (e.g., page 32, lines 24-34). The elements 124 and 125 are clearly shown in FIGS. 16 and 17.

Thus, inasmuch as a "detection unit" is depicted in one or more of the drawings, Applicants respectfully submit that the drawings are in full compliance with 37 CFR 1.83(a). Accordingly, withdrawal of this ground of objection is respectfully requested.

#### **Objection to Specification**

The objection to the specification for attempting to incorporate allegedly essential material into the application by reference to three Japanese patent publications is respectfully traversed.

The documents JP 2000-321270, H5-1983, and H6-15772 are merely identified in the Background section of the specification for their descriptions of conventional analyzers. No language indicating any desire on the part of Applicants to incorporate these documents by reference was employed anywhere in the specification.

Accordingly, withdrawal of this ground of objection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 112, First Paragraph**

The rejection of claims 27-28 and 41-42 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement is respectfully traversed.

The recitation that "the pipette is washed with the washing solution when the analysis result is less than a predetermined value, and the pipette is washed with the acidic solution when the analysis result is equal to or greater than the predetermined value" is fully supported by the description in the specification as filed (e.g., page 33, line 21 to page 35, line 28; etc.). Accordingly, Applicants respectfully submit that one of ordinary skill in the art would reasonably have concluded from the description in the specification that Applicants had possession of the claimed invention at the time the application was filed.

For at least these reasons, withdrawal of this ground of rejection is respectfully requested.

**Claim Rejections – 35 U.S.C. § 112, Second Paragraph**

The rejection of claims 26-28, 33-35, 39-44, and 46 under 35 U.S.C. § 112, second paragraph, as being unclear for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention is respectfully traversed.

The recitations identified by the Examiner in section 8 of the Office Action (pages 5-6) clearly set forth elements of the claimed invention in a manner that particularly points out and distinctly defines the metes and bounds of the subject matter for which patent protection is sought, and which would be readily understood by one of ordinary skill in the art—both on their face and in light of the description provided in the specification.

While the comments in the Office Action appear to suggest that "means plus function" language would be preferable for several of the recited elements (e.g., the "sample preparation unit" and "controller"), Applicants respectfully draw attention to MPEP § 2173.02, which states as follows:

The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets

the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available. When the examiner is satisfied that patentable subject matter is disclosed, and it is apparent to the examiner that the claims are directed to such patentable subject matter, he or she should allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire. Examiners are encouraged to suggest claim language to applicants to improve the clarity or precision of the language used, but should not reject claims or insist on their own preferences if other modes of expression selected by applicants satisfy the statutory requirement.

For at least the reasons set forth above, Applicants respectfully submit that the claims as written particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Accordingly, reconsideration of and withdrawal of this ground of rejection is respectfully requested.

#### **Claim Rejections – 35 U.S.C. § 102**

The rejection of claims 26, 33-35, 39-40, 43-44, and 46 under 35 U.S.C. § 102(b) as being anticipated by *Chupp et al.* (U.S. Patent No. 5,631,165) is respectfully traversed.

*Chupp et al.* describes a method for performing automated hematology and cytometry analysis; however, *Chupp et al.* fails to teach, either expressly or inherently, each and every element recited in rejected independent claims 26, 35, 40, and 46. At a minimum, *Chupp et al.* contains no teaching or suggestion of "an acidic solution" as recited in each of the independent claims. As a consequence of this silence, *Chupp et al.* also contains no teaching or suggestion of the other recited elements of the claimed invention that are configured for use with the "acidic solution" (e.g., the "sample preparation unit," the "pipette washing unit," etc.).

As in previous Office Actions, the Examiner has argued that any recitations relating to the "acidic solution" cannot be accorded patentable weight since the acidic solution itself is not positively recited. Applicants once again respectfully request reconsideration of this position. As noted in MPEP §2111.04 and in various precedent,

whether or not phrases such as "adapted to," "adapted for," and the like limit the scope of claims in which they appear is a highly fact specific determination. In the present context, Applicants respectfully submit that the recitations of various elements with respect to the recited "acidic solution" convey sufficient structure as to be afforded patentable weight. As before, Applicants respectfully draw attention to MPEP § 2173.05(g), which states:

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element...to define a particular capability or purpose that is served by the recited element.

In view of the above, Applicants respectfully submit that the recitation of the "acidic solution" must be evaluated and considered for purposes of determining the patentability of the claimed invention regardless of whether or not the Examiner regards this recitation as merely functional. Thus, inasmuch as *Chupp et al.* fails to teach or suggest any "acidic solution"—much less the other recited elements of the claimed invention that are configured for use with the "acidic solution" (e.g., the "sample preparation unit" and the "pipette washing unit")—a rejection under 35 U.S.C. § 102 is improper in view of MPEP § 2131, which states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)."

Finally, and notwithstanding the above, Applicants note that independent claim 46—which has also been rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by *Chupp et al.*—positively recites "a solution container comprising an acidic solution used for the diluting of the sample by the sample preparation unit and for the washing of the pipette by the pipette washing unit" (emphasis added). Thus, the argument advanced in the Office Action that the "acidic solution" cannot be accorded patentable weight since the acidic solution itself is not positively recited cannot be extended to independent claim 46.

Inasmuch as *Chupp et al.* contains no teaching or suggestion of "an acidic solution"—much less any teaching or suggestion of a "sample preparation unit" and/or a

"pipette washing unit" as recited in the independent claims, Applicants respectfully submit that the claimed invention is neither anticipated by nor would have been obvious in view of this reference. Accordingly, withdrawal of this ground of rejection is respectfully requested.

#### **Double Patenting**

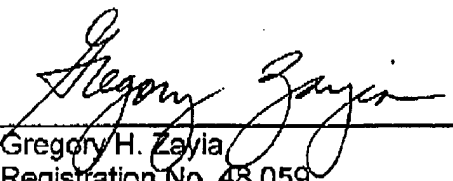
It is respectfully requested that the provisional rejection of claims 26, 35, 40, and 46 on the ground of nonstatutory obviousness-type double patenting over claim 6 of co-pending Application Serial No. 11/729,017 be held in abeyance until such time as allowable subject matter in co-pending Application Serial No. 11/729,017 has been indicated.

#### **Conclusion**

In view of the Remarks set forth above, Applicants respectfully submit that the claimed invention is in condition for allowance. Early notification to such effect is earnestly solicited.

As noted above, if for any reason the Examiner feels that the above Remarks do not put the claims in condition to be allowed, it is respectfully requested that the Examiner contact the undersigned agent directly at (312)-321-4257 in order to arrange a personal interview to discuss this case prior to the issuance of any further rejections.

Respectfully submitted,

  
Gregory H. Zayia  
Registration No. 48,059  
Agent for Applicants

BRINKS HOFER GILSON & LIONE  
P.O. BOX 10395  
CHICAGO, ILLINOIS 60610  
(312) 321-4200